

Appl. No. 09/890,702

UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No.	09/890,702	Confirmation No.
6219		
Applicant	Claudio Cabano	
Filed	January 09, 2002	
Title	Method for finding members of a common interest group	
TC/AU	2684	
Examiner	Sujatha R. Sharma	
Docket No.	33835	
Customer No.	116	

Commissoner for Patents  
Alexandria, VA 22313-1450

**SECOND SUPPLEMENTAL DECLARATION UNDER 37 CFR 1.131**  
**ESTABLISHING PRIOR INVENTION**

Sir:

This Declaration under 37 CFR 1.131 is filed along with supporting material and an Amendment in response to the Office action of October 1, 2006. This declaration supplements the declaration under 37 CFR 1.131 already filed in this case, and should be considered by the Examiner in light of the accompanying response and the previous responses.


DECLARATION OF CHRISTOPHE SAAM UNDER 37 CFR1.131

I, Christophe Saam, hereby declare

1. I am a European Patent Attorney and was employed by Patents & Technology Surveys SA at all times relevant to the statements being made herein.
2. I was responsible for the preparation and filing of International application PCT/CH99/00463 filed on September 29, 1999 and published under the number WO0124551, now pending at the USPTO under the above-cited U.S. application 09/890,702.
3. The claimed subject matter of the above-cited U.S. application was discussed in a first meeting on or about June 21, 1999 and another meeting on or about July 31, 1999 as attached in Exhibit A ("Ihre geplante Patentanmeldung – Fall 87 – "Profile Hosting") and Exhibit B ("7) Fall 87 – Profile Hosting"). It was agreed that prior to filing a patent application a preliminary Search would be done. The results of the preliminary search were confirmed with a letter dated from August 24, 1999 as attached in Exhibit A.
4. The invention disclosure I received and used during the preliminary search is dated July 22, 1999 as attached in Exhibit C ("Memo For internal use only").
5. I diligently prepared the patent application, without abandonment, during the period between June 21, 1999 and the Swiss filing date of September 29, 1999, which is a typical and reasonable time for preparing such a patent application. I made a first draft of the application and submitted said draft to the client on September 16, 1999.
6. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that a wilful false statement and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such

Appl. No. 09/890,702

will false statements may jeopardize the validity of the application or any patent issued thereon.

Signature:  Date: Feb. 5, 2008  
Christophe Saam

Citizenship: Switzerland

Residence (City, State, Country): Neuchâtel, NE, Switzerland

Post Office Address: Verser - Rand 9  
CH - 2000 Neuchâtel

Attachments:

- Exhibit A ("Ihre geplante Patentanmeldung – Fall 87 – "Profile Hosting") (2pp)
- Exhibit B ("Protokoll unserer Sitzung vom 30. Juli 1999") (3p9)
- Exhibit C ("Memo For internal use only") (5pp).

A-Post

Swisscom AG, Mobile Com  
Herrn E. Lauper  
PH-MC-BD-MSU-RPA  
3050 Bern  
CH

COPIE

Unser Zeichen	SWS-87-PCT / CS
Ihr Zeichen	"Profile Hosting"
Datum	24. August 1999

Ihre geplante Patentanmeldung - Fall 87 - "Profile Hosting"

Sehr geehrter Herr Lauper,

Gemäss unserer Besprechung am 21. Juni 1999 haben wir eine Vorabrecherche über die oben angegebene Patentanmeldung durchgeführt. In der Beilage finden Sie das Protokoll dieser Recherche.

Trotz aufwendigen Recherchen haben wir kein Patentedokument gefunden, das die Neuheit oder die erfinderische Tätigkeit dieser Anmeldung vorwegnimmt.

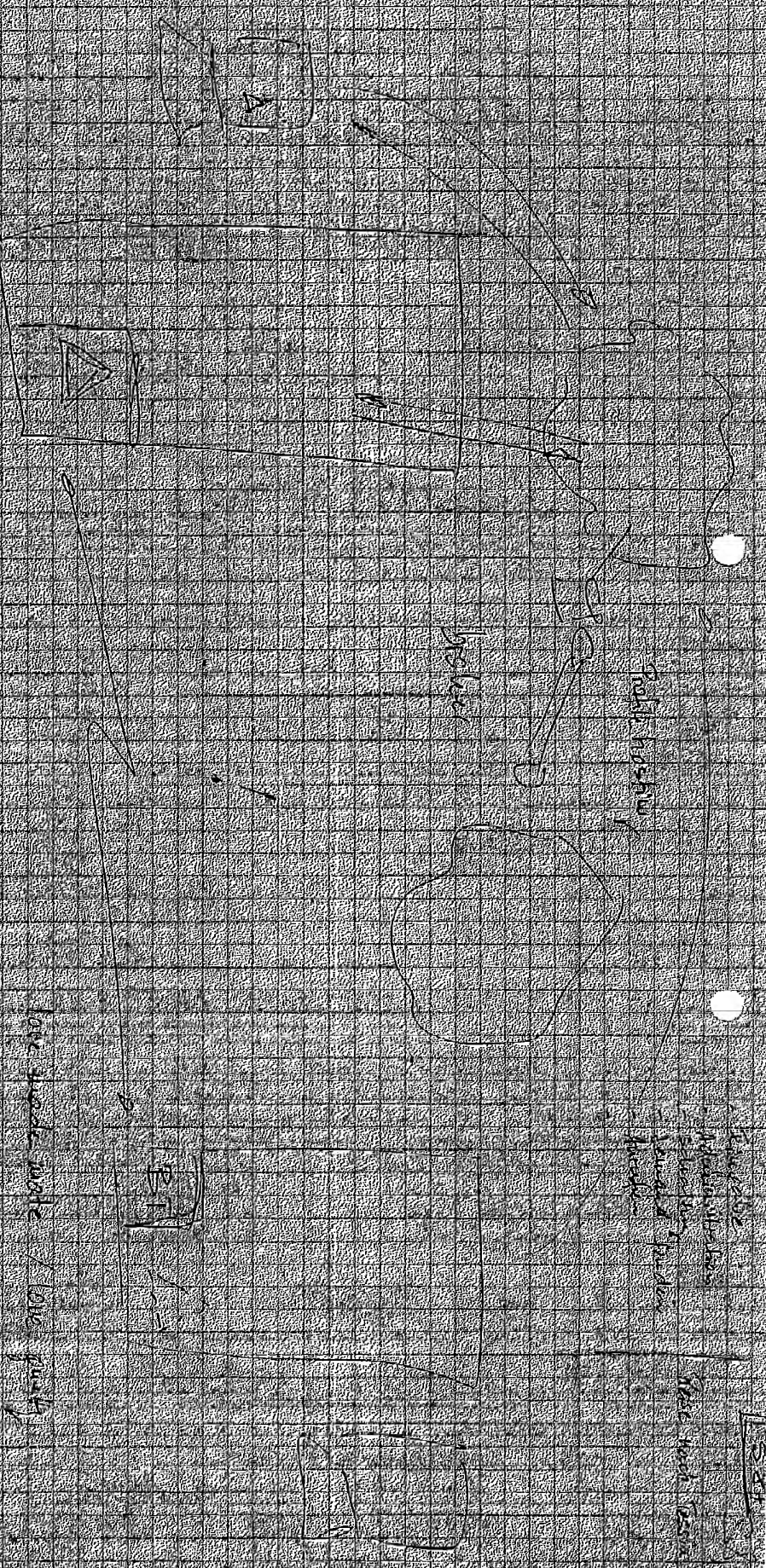
Wir werden daher so schnell wie möglich einen Entwurf für diese Patentanmeldung vorbereiten und Ihnen unterbreiten.

Mit freundlichen Grüssen

Patents and Technology Surveys  
Fornerod & Saam

Christophe Saam

Beilage: erwähnt



Concrete for noise (CPFL)

Proximity to dual structures  
to make transition between system / interface

to make / manage self enclosure

to broadcast

with future development / expansion / growth

to make / manage self enclosure

to make / manage self enclosure

to make / manage self enclosure

to make / manage self enclosure

to make / manage self enclosure

to make / manage self enclosure

CL 1222 44

A-Post

SWISSCOM AG  
PH-MC-BD-MSU-RPA  
zHv Herrn Eric Lauper  
3050 Bern

COPIE

Unser Zeichen      CG / CS  
Ihr Zeichen  
Datum              31. Juli 1999

Protokoll unserer Sitzung vom 30. Juli 1999  
Anwesend: Herr Lauper, Herr Saam

Sehr geehrter Herr Lauper,

Hiermit möchten wir die verschiedenen Punkte, die während der oben erwähnten Sitzung diskutiert worden sind, bestätigen:

1) Fall 2 - SICAP

Wir werden noch klären, ob die Einspruchsrücktrittserklärung von Giesecke und Devrient beim EPA eingegangen ist.

2) Fall 52

Das Dokument US5872837 (MCI) hat mindestens gewisse Ähnlichkeiten mit Ihrem Fall 52, so dass wir Ihnen empfehlen, mit Herrn Vogel über eventuell benötigte Anpassungen an diesen Fall zu diskutieren.

3) SWS-81-PCT (111+5)

Diese Anmeldung werden Sie nicht weiterverfolgen. Sie werden noch untersuchen, ob dieser Dienst auch aus dem Ausland zugänglich ist.

#### 4) Fall SWS-R-26 und SWS-83-PCT (Antidiebstahl)

Die Ergebnisse unserer neuen Recherche wurden besprochen. Ausführlichere Kommentare und Empfehlungen senden wir Ihnen so schnell wie möglich.

Unser Dossier haben wir entsprechend geschlossen. Wir erlauben uns, unsere Bemühungen in dieser Angelegenheit in Rechnung zu stellen.

#### 5) SWS-84-PCT

Der Fall 24 wurde vermutlich veröffentlicht. Wir werden unseren Entwurf entsprechend anpassen.

#### 6) Fall 86 – SMS over USSD

Gerne möchten wir Ihnen hiermit bestätigen, dass wir eine Vorabrecherche und falls positiv, eine PCT-Anmeldung gemäss den von Ihnen gelieferten Angaben ausarbeiten werden und Ihnen vor unseren Sommerferien unterbreiten werden.

Wir bestätigen ferner, dass die Anmeldung im Namen der SWISSCOM AG eingereicht werden soll; die Korrespondenz und die Rechnungen werden ebenfalls auf denselben Namen ausgestellt.

Von Ihnen erwarten wir noch eine Kopie der Spezifikationen von USSD. Ausserdem stellt sich noch die Frage, ob USSD auch aus einem Netz ohne Roamingsabkommen mit dem Home Provider eines Mobilteilnehmers gesendet werden können.

#### 7) ~~Fall 87~~ Profile Hosting

Gerne möchten wir Ihnen hiermit bestätigen, dass wir eine Vorabrecherche und falls positiv, eine PCT-Anmeldung gemäss den von Ihnen gelieferten Angaben ausarbeiten werden und Ihnen vor unseren Sommerferien unterbreiten werden.

Wir bestätigen ferner, dass die Anmeldung im Namen der SWISSCOM AG eingereicht werden soll; die Korrespondenz und die Rechnungen werden ebenfalls auf denselben Namen ausgestellt.

#### 8) Recherchenfall R4 - VRD

Ausser den Schutzbereich des Patents WO98/33315 (University of Texas) werden wir Ihre Gültigkeit analysieren.

9) Angebot von CD-Roms von Derwent.

Bevor wir dieses Produkt bestellen, werden wir noch klären, ob Scriptanpassungen im Kostenvoranschlag enthalten sind.

10) Allgemeines

Sie werden uns eine Liste der Anmeldungsdatums Ihrer Anmeldungen zukommen lassen.

Von unserem Programm für standardisierte Abläufe und Kostenreduktion haben Sie Kenntnis genommen.

Für das uns entgegengebrachte Vertrauen danken wir Ihnen bestens.

Mit freundlichen Grüßen

Patents and Technology Surveys  
Fornerod & Saam

Christophe Saam

Beilagen: erwähnt



Erfinder

From: Adriano Huber, David Perels, Claudio Cabano

Date: 31. March 1999

Subject: Mobile Meet Friends and Business Partners

Copy to: Eric Lauper

Cc

**Patent Idea for Mobile Meet Friends and Business Partners****Abstract/Scope**

The post-industrial society is changing quickly. People are losing their roots, need to work in a more inter-connected world, need to meet other people, need to keep contact with older friends or business partners. This applies both to the private environment as to the business environment.

The introduction of new mobile computing technologies enables the provision of a service that fulfill all these needs. This description addresses the methods necessary to provide these services.

**Functionality**

Different Groups: User, Group, Community  
Create/Admin User, Group, Community  
Personal / Business / Info  
Profiling  
Loyalty programs  
Preferred Meeting Points  
Alerts  
Meetings  
Active/Passive meeting establishment (push/pull)  
Positioning vs. privacy  
Anonymity vs. Certification of identity  
Negotiation/confirmation  
Preferred I/O (various devices or access methods)  
Device  
Web Homepage  
Fundgrube  
Conferences

**Games**

Communities: anonymous, temporary, ....

**Technical**

Localisation/Polling

Bluetooth, short range

Broadcasting (for parties, broadcast an alle der der gleiche Community gehören.)

Database in the Network

Profile brooker (für Roaming, mapping von Profile)

Interfaces (PC, TV, DAB, Mobile, Bluetooth&Jini, Proximity Detector, short range detectors, pager, mail, ...)

Web interface

Download von Profiles to the phone (phone, organiser, watch).

2 possible solutions:

- 1) proximity detector -> triggers the process when corresponding transmitter is in range (Lovegetty priciple)
- 2) network side monitoring of all subscribers participating

In order not to continuously monitor the interactions some meeting points can be defined. The server checks the positions only when near to the meeting points.

**Profile:**

- alter etc
- fotos
- interessen
- an Ausstellungen gegangen
- schlaue funktion um profil auf

**Admin**

Timedependent

User / Group / Community

**Location (Meeting Points)**

Personal profile: new friends, old friends, new business partners, old business partners.

Device, I/O interfaces

**Possible interested partners for such a service**

Swisscom (Mobile, DM, Broadcast)

Partners (Branding...)

Meeting Points: Loeb, MacDonalds, Lorenzini, Kincs, SBB

SRG, DRS, Local, ... (?)

**Device**

Mobile Phone

New: special device with GPS, GSMlight, watch, clips, ...

**Technical solutions**

get in the system/ subscribe the service

set up a group

register for a group

activate the monitoring or the beacon transmitter (2 possible solutions)

trigger the process (the database check) when near to a Meeting Point or near a

trigger the process when near to an active transmitter

information of possible meeting

negotiation of credentials

communication (possibility to directly call the user)

guidance to the meeting

get out from the system/ unsubscribe the service

Profilierung datenbank

- profilierung
- koordinaten
- aufträge
- aktiv oder passiv (nicht gestört werden)

Mapquest/datenbank

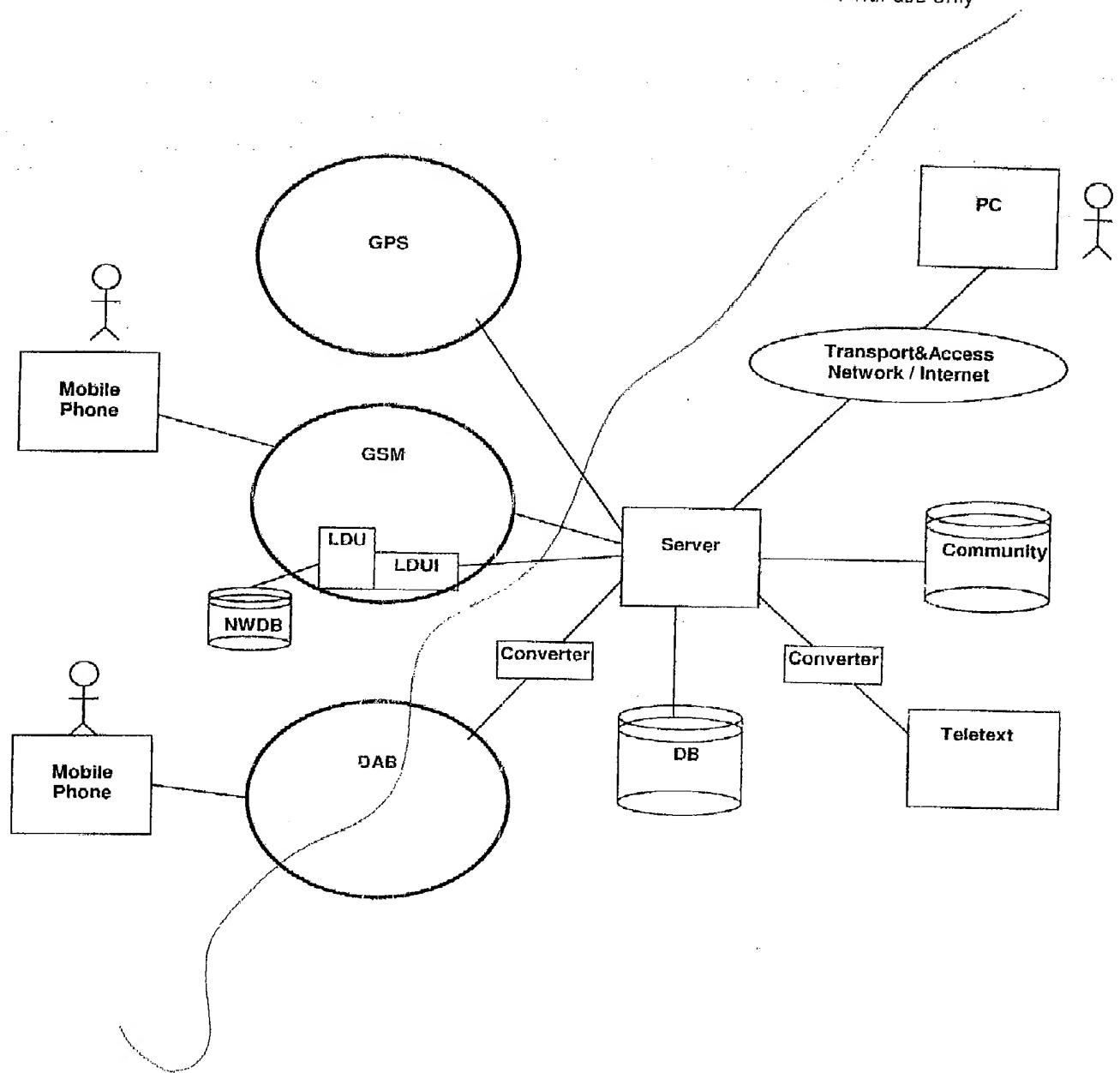
Prozess

User schaltet ein.

Monitor für aktive leute

## Memo

For internal use only



**Document 1: letter to Swisscom AG dated 24 August 1999**

Priority mail

Swisscom AG, Mobile Com.  
Mr. E. Lauper  
PH-MC-BD-MSU-RPA  
3050 Berne  
Switzerland

Our ref. SWS-87-PCT / CS  
Your ref. "Profile Hosting"  
Date August 24, 1999

**Your planned patent application – case 87 – "Profile Hosting"**

Dear Mr Lauper

Following our discussion on June 21, 1999, we have performed a preliminary search regarding the above-referenced patent application. In attachment you will find the protocol of this search.

Despite extensive searches, we have not found any patent document that could anticipate the novelty or the inventiveness of this invention.

We will therefore proceed as fast as possible with preparing and submitting to you a draft for this patent application.

Very truly yours  
Fornerod & Saam

Christophe Saam

Encl. a/s

**Document 2: manuscript drawings and notes in 2 different hands,  
dated 22 July 1999**

((Upper half))

Case S87

Profile Hosting

- Input
- Administration
- Circuit
- Finding someone
- Calling

Trip to Ticino

Broker

((Lower half))

- certificate for being admitted in a group accredited by the authority (EPFL)
- job marketing
- trip to Ticino
- common interest (colleagues from 3C forum)
- "profile is in vicinity" -> accept/reject also reject calls received
- supported by LDS (location dependent services)
- community spirit (portal)
- "university colleagues", watch list
- proximity e.g. through Bluetooth
- broker between several systems interface between France Telecom and Swisscom
- private / anonymous to log in
- broadcast
- predefined keywords / templates / weighting for the profiles
- indication newsgroups
- distance – functions
- temporally limited profiles limited in time ((undecipherable text))
- charging – meeting (charging to open) meeting occurred
- restaurant / cinema / booking a table

EL/22.07.99

**Document 3: letter to Swisscom AG dated 31 July 1999**

Priority mail

Swisscom AG  
PH-MC-BD-MSU-RPA  
Mr Eric Lauper  
3050 Berne

Our ref. CG / CS  
Your ref.  
Date July 31, 1999

**Minutes of our meeting of July 30, 1999**  
**Participating: Mr Lauper, Mr Saam**

Dear Mr Lauper

Hereby, we wish to confirm the different points that have been discussed during the above-mentioned meeting:

[...]

7) Case 87 – Profile Hosting

We are pleased to confirm that we will perform a preliminary search and, if the results prove positive, we will prepare a PCT application on the basis of the indications you supplied and submit it to you before the summer holidays.

We further confirm that the application is to be filed in the name of Swisscom AG; correspondence and invoices will also be established in the same name.

[...]



## **Document 4: Swisscom memo dated 31 March 1999**

((p. 1))

Memo  
For internal use only

From       Adriano Huber, David Perels, Claudio Cabano  
Date        March 31, 1999  
Subject     Mobile Meet Friends and Business Partners

### **Patent idea for Mobile Meet Friends and Business Partners**

#### **Abstract/Scope**

((already in English))

#### **Functionality**

((already in English save the word "Fundgrube" which means: "treasure trove"))

((p. 2))

Memo  
For internal use only

#### **Games**

((already in English))

#### **Technical**

Localisation/polling

Bluetooth, short range

Broadcasting (for parties, broadcast to all those who belong to the same community)

Database in the network

Profile broker (for roaming, mapping of profile)

Interfaces (PC, TV, DAB, mobile, Bluetooth & Jini, Proximity Detector, short range detectors, pager, mail...)

Web interface

Download of profiles to the phone (phone, organizer, watch)

2 possible solutions:

((already in English))

#### **Profile:**

- age etc.
- photographs
- interests

- went to exhibition
- smart function for generating profile

#### **Admin**

((already in English))

#### **Possible interested partners for such a service**

((already in English))

#### **Device**

((already in English))

#### **Technical solutions**

((already in English))

((p. 3))

#### **Profiling database**

- profiling
- coordinates
- orders
- active or passive (do not disturb)

Mapquest / database

#### **Procedure**

User switches on  
Monitor for active people

((p. 4))

((already in English))